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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,404	11/13/2003	Stephan S. Porter	47168-00245USPT	9907
30223	7590	06/21/2006	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/713,404	<b>Applicant(s)</b> PORTER ET AL.	
	<b>Examiner</b> John J. Wilson	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.  
     4a) Of the above claim(s) 58-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 and 67-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/13/04 1/31/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS Cont' 3/28/05</u> .                |

### ***Election/Restrictions***

Applicant's election of the Group I invention, claims 1-57 and 67-70 in the reply filed on May 2, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 58-66 stand withdrawn as being directed to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 13-22, 26, 29-35 and 46-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Constantino (2003/0224327). Constantino shows an implant 12, Fig. 4, proximal end as shown at bottom of the figure, interior bore 20, first anti-rotation cavity 32 [0027] in the form of a hexagonal socket that inherently has a first minor diameter and a second anti-rotational cavity 18 [0021] and [0027]-[0028] in the form of a hexagon that inherently has a second minor diameter, and as shown in the drawing, the

second minor diameter is no greater than the first. As to claims 2, the shown hexagons are inherently capable of functioning to mate with a tool. As to claim 3, the shown hexagon inherently comprises obtuse angles. As to claim 13, see tool 10. As to claim 14, the shown spaced anti-rotation features are inherently capable of providing independent rotational resistance. As to claim 29, Constantino shows a table at the surface facing down in Fig. 4. As to claim 50, Constantino shows all of the actual claimed structure, the nature of the relationship of inferentially claimed abutments is given no patentable weight.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Klardie et al (5782918). Constantino shows the structure as described above, however, does not show a first axial retention section for coupling with a device, or as to claim 9, a recess. Klardie shows a first axial retention section 31 below an anti-rotation cavity 21, and as to claim 9, a recess 34 for receiving a resilient lip 62. It would be obvious to one of ordinary skill in the art to modify Constantino to include the retention section and recess of Klardie in order to better lock the device to the implant.

Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Klardie et al (5782918) as applied to claims 9 and 27 above, and further in view of Sutter (6227859). The above combination does not show a second axial retention section having a threaded section. Sutter shows an implant, Fig. 1, having an anti-rotation cavity 15, recess 16 and threaded retention section 19. It would be obvious to one of ordinary skill in the art to modify the above combination to include a threaded section as shown by Sutter in order to use a screw to more positively lock the elements together.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Klardie et al (5782918) as applied to claim 8 above, and further in view of Sutter (6227859). Constantino shows the structure as described above, however, does not show a first axial retention section having a threaded section. Sutter shows an implant, Fig. 1, having an anti-rotation cavity 15, recess 16 and threaded retention section 19. It would be obvious to one of ordinary skill in the art to modify Constantino to include a threaded section as shown by Sutter in order to use a screw to more positively lock the elements together.

Claims 12, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Gallicchio (6663389). Constantino shows the structure as described above, and further, shows a driving tool 10, however, while

Constantino describes a prosthetic engagement, the reference does not specifically state using an abutment. Gallicchio shows an implant including a first anti-rotation cavity 392, Fig. 12, second anti-rotation cavity 221 and an abutment 203, Fig. 17, that is adapted to engage the second anti-rotation means. It would be obvious to one of ordinary skill in the art to modify Constantino to include an abutment as shown by Gallicchio in order to better mount a prosthetic to the implant. As to claim 67, to call tool 10 of Constantino a mount is merely terminology and/or intended use, and as such, is not given any patentable weight.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Duerr et al (5823776). Constantino shows the structure as described above, however, does not show an anti-rotation feature that is adapted to enable rotational adjustments of 30 degrees for an abutment. Duerr teaches an anti-rotation feature 26', column 5, lines 5-7, that allows for 30 degrees of adjustments. It would be obvious to one of ordinary skill in the art to modify Constantino to include an adjustment feature as shown by Duerr in order to better align the prosthetic tooth with other teeth in the mouth.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Bassett et al (6012923). Constantino shows the structure as described above, and further, teaches that the polygonal surface may be internal or external and may have different shapes, see last line of [0006],

however, Constantino does not show two anti-rotation features adapted to have different incremental adjustments. Bassett teaches using different polygonal shapes to provide for double indexing, column 7, lines 35-42. It would be obvious to one of ordinary skill in the art to modify Constantino to include different shapes to allow for different incremental adjustments as shown by Bassett in order to better align the prosthetic tooth with other teeth in the mouth.

Claims 36 and 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Gittleman (2002/0127515). Constantino shows an implant 12, Fig. 4, interior bore 20, first anti-rotation cavity 32 [0027] in the form of a hexagonal socket that inherently has a first minor diameter and a second anti-rotational cavity 18 [0021] and [0027]-[0028] in the form of a hexagon. While Constantino teaches a prosthetic engagement, the reference does not show using first and second abutments. Gittleman shows a first abutment 65, Fig. 3, having a non-locking portion 63 and a locking portion 57, and shows a second abutment 6, Fig. 2, having a locking portion 9. The implant and abutments are merely listed in the claims and not structurally tied together. It would be obvious to one of ordinary skill in the art to modify Constantino to include the abutments as shown by Gittleman because the list of elements is properly met by listing the same elements shown in prior art. The manner in which the elements may be used together is merely intended use.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Gittleman (2002/0127515) as applied to claim 36 above, and further, in view of Sager (6315563). The above combination does not show a distal non-locking portion. Sager shows an abutment 32 having a distal non-locking portion 44. It would be obvious to one of ordinary skill in the art to modify the above combination to include an abutment having a distal non-locking portion as shown by Sager in order to better stabilize the abutment within an implant.

Claims 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Broberg et al (6280195). Constantino shows an implant 12, Fig. 4, interior bore 20, first anti-rotation cavity 32 [0027] in the form of a hexagonal socket that inherently has a first minor diameter and a second anti-rotational cavity 18 [0021] and [0027]-[0028] in the form of a hexagon. Constantino teaches driving the implant in the bone [0021] and teaches that 32 is a prosthetic engagement socket [0027], however, does not specifically state the type of prosthetic used and, as to claim 52, does not show selecting an abutment from a plurality of abutments. Broberg teaches using an abutment 31a as part of a prosthetic and, as to claim 52, teaches selecting the abutment from a plurality of abutments, column 5, line 65 through column 6, line 5. It would be obvious to one of ordinary skill in the art to modify Constantino to include using an abutment and to include the step of selecting the abutment from a plurality of abutments as shown by Broberg in order to better match the abutment with the needs of the patient. With respect to the abutment being coupled after the implant



is installed, Constantino teaches driving the implant into the bone with tool 10, and therefore, inherently teaches attaching the prosthetic after the implant is installed as is also well known in the art. As to claim 53, to select the abutment based on conditions in the patient's mouth would be obvious to the skilled artisan.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Broberg et al (6280195) as applied to claim 55 above, and further, in view of Kumar (6217332). The above combination does not show removing the drive tool and implant from a package. Kumar teaches removing a drive tool 119 and implant 120 for a package. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a package as shown by Kumar in order to improve convenience and hygiene.

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Gallicchio (6663389) as applied to claim 67 above, and further, in view of Kumar (6217332). The above combination does not show removing the drive tool and implant from a package. Kumar teaches removing a drive tool 119 and implant 120 for a package. It would be obvious to one of ordinary skill in the art to modify the above combination to include a package as shown by Kumar in order to improve convenience and hygiene.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Constantino (2003/0224327) in view of Gallicchio (6663389) as applied to claim 67 above, and further, in view of Beaty et al (5685715). The above combination does not show using an impression coping for the mount. Beaty shows an impression coping 10 as a mount. It would be obvious to one of ordinary skill in the art to modify the above combination to include an impression coping as shown by Beaty in order to better take an impression when needed.

Claims 67, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fried et al (5810590) in view of D'Alise (5755574). Fried shows an implant, Figs. 9-13, first anti-rotation feature 92 and second anti-rotation feature 94. Fried does not show a mount or an abutment. D'Alise teaches including a mount 40 and an abutment 44. It would be obvious to one of ordinary skill in the art to modify Fried to include a mount and an abutment as shown by D'Alise in order to conveniently provide the needed elements for a procedure. As to claim 70, D'Alise also shows providing an impression coping mount 48.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-57 and 67-70 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-35 of copending Application No. 10/713,328. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not include a feedback feature is an obvious matter of choice in not using a claimed feature to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Drawings***

The drawings filed November 13, 2003 have been found to be acceptable by the examiner.

### ***Claim Objections***

In claim 24, line 2, see "daped".

***Information Disclosure Statement***

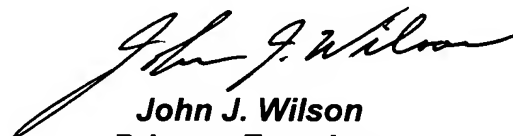
The Information Disclosure Statements filed May 13, 2004, January 31, 2005 and March 28, 2005 have been considered and an initialed copy of each is attached.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
June 14, 2006